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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,912	06/28/2001	John William Richardson	PU010139	5397

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JOSEPH S. TRIPOLI
THOMSON MULTIMEDIA LICENSING INC.
2 INDEPENDENCE WAY
P.O. BOX 5312
PRINCETON, NJ 08543-5312

EXAMINER

JAROENCHONWANIT, BUNJOB

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/893,912

Applicant(s)

RICHARDSON ET AL.

Examiner

Bunjoo Jaroenchonwanit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/12/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

RD

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DETAILED ACTION

1. This Office Action is in response to the submission filed 04/12/05. Examiner notes that no claims were amended or cancelled; claims 16-18 are added. Claims 1-18 are pending for examination. The rejection to claims 1-15 is maintained. Newly rejection to claims 16-18 are as started below.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1, 3, 6, 7 and 13 are rejected under 103(a) as being unpatentable under Applicant Admission Prior Art (AAPA) and Mao et al. (US 2002/0108119).

4. Claims 5, 14 and 15 are rejected under 103(a) as being unpatentable under AAPA-Mao, as applied to claim 1, in view of Diong (US 2002/0165953).

5. Claims 2, 4 and 8-12 are rejected under 103(a) as being unpatentable under AAPA-Mao, as applied to claim 1, in view of what was well known in the art.

6. AAPA, Mao and Diong have been cited for claims' rejections in the last Office Action. Instead of reiterate the last rejections *in toto*, the rejections and citations applicable, in the previous Office Action, are hereby incorporated by references.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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8. Claims 16-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification as originally filed does not provide support to exclude the use of claim invention to from being utilized as unrelated channel change. It is apparent that the newly claims are added, with the benefit of hindsight vision, exclusive to Mao's application. The mere absence of a positive recitation is not basis for exclusion. Applicant merely seeks to claim the invention in terms of what it was not, rather than pointing out the invention.

9. Claims 16 and 17 are rejected under 103(a) as being unpatentable under AAPA- Mao, as applied to claims 1 and 13, above.

10. AAPA-Mao discloses the invention substantially, as claimed, but it is silent on utilizing the invention for application(s) other than channel changed, i.e. unrelated channel changed. However, the claimed inventions clearly recite the intended use of IP-ATM encapsulation within the existing network infrastructure, for application other than channel controlling. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made that was a matter of choice to exclude any non desirable applications, such exclusion does not construe any new invention nor any unexpected result. The choice of applying the claimed invention(s) to any specific application(s) is akin to the choice of using computer that capable of executing a word processor to using Microsoft Word but not to use Word perfect, which is depend on users' desirable.

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11. Claim 18 is rejected under 103(a) as being unpatentable under AAPA-Mao-Diong, as applied to claim 15, above.

12. AAPA-Mao-Diong discloses the invention substantially, as claimed, but it is silent on utilizing the invention for application(s) other than channel changed, i.e. unrelated channel changed. However, the claimed inventions clearly recite the intended use of IP-ATM encapsulation within the existing network infrastructure, for application other than channel controlling. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made that was a matter of choice to exclude any non desirable applications, such exclusion does not construe any new invention nor any unexpected result. The choice of applying the claimed invention(s) to any specific application(s) is akin to the choice of using computer that capable of executing a word processor to using Microsoft Word but not to use Word perfect, which is depend on users' desirable.

Response to Arguments

13. Applicant's arguments filed 04/12/05 have been fully considered but they are not persuasive. In the remark applicant argued in substance that:

a. Mao does not teach ATM/DSL, as to this point of contention, the argument does not commensurate with the language of claim 1, because the argument is directed to preamble of the claim. In other words, the recitation ATM/DSL has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the

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preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

b. As to claims 13 and 15, Moa does teach the master head end is couple to ATM network (§ 32). In addition, applicant seems to argue against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this instance, the network infrastructure is clearly admitted by the applicant and stated in Examiner's rejection. The claims in context employ existing ATM-IP network communications and conventional packet encapsulation to communicate packet from ATM network utilizing IP network, such employment is clearly described in Mao, which intended to expand network communications by taking advantage from conventional IP network. Regarding to the applied references do not teach ATM/DSL, applicant is directed to Applicant's specification (fig. 1, page 1, line 9- page 2, line 30), which clear admitted an existing state of ATM/DSL, its' deficiency and intended to improve the deficiency, which they are prior art admission.

c. Regarding to none of the applied reference suggested IP encapsulation from a computer in a CPE to the NCE that included ATM/DSL, via HTTP server couple to NCS. Clearly the infrastructure such as a computer in a CPE including ATM/DSL and coupled to HTTP server is described in Specification figure 1, which is admitted prior art. With respect to a computer to perform IP encapsulations (see Mao, ¶ 29, 32, since the master

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headed coupled to remote headed via ATM network, communications between the same must include ATM/IP encapsulation).

d. In response to applicant's argument that Mao does not teach ATM/DSL service system, but rather distinguish itself from DSL and not even mention ATM. Applicant is directed to Mao (§ 32). Although, Mao's teaching IP packet encapsulation over ATM and Cable network but it deals specifically with cable modem. Regardless of silencing on DSL, it would have been obvious to an ordinary artisan to adopt an idea of encapsulation applicable for Cable modem to DSL modem, because they interrelated and their purpose are akin to, that in an attempting to expand horizon of network communication across communication protocols. Beside, it is not necessary that the secondary reference must have all limitations or must have the deficiency elements, in order for the artisan to combine. In contrary, if the reference lacks of deficiency, by itself would be sufficient for claims' rejection. In response to applicant's argument that all limitation must be taught in the reference, Examiner contended, all alleged absent element, are taught by applicant own admission, which taught a great deal of claims' limitation (see Spec. Pages 1-2 and figure 1).

e. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*,

958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation of adopting IP encapsulation across network protocols, such as IP to SDH/ATM network using Cable modem as suggested in Mao to the use of DSL modem, would be to benefit from flexibility and availability, since these two network infrastructures are not necessary coexisted in all geographical areas.

f. In response to applicant's argument that none of the references singly or in combination teach all limitation of the claims. Examiner contended that applicant own admission is also reference and taught more than half of claims limitations (see Spec. Pages 1-2 and figure 1).

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

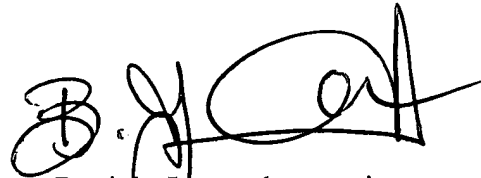
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bunjob Jaroenchonwanit whose telephone number is (571) 272-3913. The examiner can normally be reached on 8:00-17:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Bunjob Jaroenchonwanit
Primary Examiner
Art Unit 2143

/bj
07/01/05